

REMARKS

The Examiner requested restriction under 35 U.S.C. § 121 to:

Group I, drawn to a semiconductor device and including claims 1-13 and 20-22, classified in Class 257, subclass 779, or

Group II, drawn to a method of fabricating a semiconductor device and including claims 14-19 and 23-29, classified in Class 438, subclass 10+.

The Applicants respectfully traverse the election requirement as the Examiner has failed to demonstrate either of the criteria necessary for a proper restriction requirement. MPEP §803 sets forth the following two criteria for a proper requirement for restriction between patentably distinct inventions:

- (1) The inventions must be independent . . . or distinct as claimed . . . ; and
- (2) There must be a serious burden on the examiner if restriction is not required.

The Examiner must provide reasons to support conclusions that the inventions are independent or distinct. The Examiner failed to satisfy criterion (1) because the reasons given by the Examiner for to the alleged independence or distinctness of the claimed invention are insufficient. The Examiner argues, "the PCB recited in claim 1 can be made through curing a silicon deposit first before printing the silicon composition". Claim 1 does not relate to a PCB. Furthermore, one skilled in the art would recognize that printing can be carried out on a silicone composition, but not on the cured product of a silicone composition, therefore, it is not possible to carry out the process in an opposite order. The Examiner failed to meet criterion (1) by failing to demonstrate the independence or distinctness of the invention as claimed because claim 1 does not relate to a PCB and because the semiconductor package as claimed cannot be made by the process proposed by the Examiner, therefore, the Examiner failed to show that the product as claimed can be made by another and materially different process.

The Examiner failed to satisfy criterion (2) because the Examiner requested restriction between two groups of claims. Patentability searches for each group of claims would have to be repeated if the restriction were limited as the Examiner required. Therefore, rather than avoiding a serious burden by issuing the present restriction requirement, the Examiner is creating a serious burden on the Patent Office via unnecessary duplication of searching effort. An important advantage of pursuing just one application and searching all claims together is that the examination work of the Patent Office would thereby be simplified inasmuch as duplication of search effort would be eliminated. By avoiding such duplication of search effort, the Patent Office saves time and expense.

In view of the foregoing, the Examiner failed to issue a proper restriction requirement. A restriction requirement is inappropriate. Therefore, the Applicants respectfully request that the restriction requirement be withdrawn.

However, if the Examiner should make this requirement final, the Applicants provisionally elect to prosecute Group I, including claims 1-13 and 20-22 at this time. The Applicants make this election with traverse. The Applicants make this election with traverse for the reasons discussed above.

The Applicants have particularly pointed out and distinctly claimed the subject matter that they regard as their invention, and the instant invention is novel and unobvious. Reconsideration of the application is requested.

The present response is being submitted within the one month response period for response to the outstanding restriction requirement. Although the Applicants believe in good faith that no extensions of time are needed, the Applicants hereby petition for any necessary extensions of time. You are authorized to charge deposit account 04-1520 for any fees necessary to maintain the pendency of this application.

Respectfully Submitted,
DOW CORNING CORPORATION



Catherine U. Brown
Attorney for Applicants
Reg. No. 44,565
(989) 496-1725